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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,470	12/08/2003	James Paul Oberkircher	2002-IP-006878 U1 USA	2880
20558	7590	11/22/2005		
KONNEKER & SMITH P. C. 660 NORTH CENTRAL EXPRESSWAY SUITE 230 PLANO, TX 75074			EXAMINER BOMAR, THOMAS S	
			ART UNIT	PAPER NUMBER
			3672	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/730,470	OBERKIRCHER ET AL.	
	Examiner	Art Unit	
	Shane Bomar	3672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 23 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 25-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/26/04, 4/21/05</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. This application contains claims directed to the following patentably distinct species of the claimed invention: Species I - embodied by Figures 1-4 wherein the lines have no connections downhole. Species II - embodied by Figures 5 and 6 wherein the lines have wet connections downhole.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 13-19, 25, and 26 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the

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examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

2. During a telephone conversation with Marlin Smith on November 8, 2005 a provisional election was made with traverse to prosecute the invention of Species I, claims 1-22 and 25-34. Affirmation of this election must be made by applicant in replying to this Office action. Claims 23 and 24 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

3. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

4. Claims 1, 2, 7-11, 26, 27, and 34 are objected to because of the following informalities:

a) in claims 1 and 27, it appears to be improper to say that there is at least one line extending into the first *and* second wellbores because this implies that there must be at least two lines. Therefore, it is suggested to replace "at least one line" with --at least two lines--, and to make corresponding changes in claims 7-10;

b) in claim 2, in further accordance with the changes suggested above, the phrase "wherein there are multiple lines, a first at least of the lines" should be changed to --wherein a

first of the at least two lines--, and “a second at least one of the lines” changed to --a second of the at least two lines--;

c) in claims 7 and 9, the recitation of “without any interruptions in the lines” seems redundant since claim 1 has already stated that there are no connections in the lines. Therefore, I would like further clarification as to what this phrase means to distinguish it from claim 1. Further, in Figure 1, above and to the left of junction 48, is the split of line 46 to be considered an interruption or a break, or neither?;

d) in claim 11, the phrase “wherein there are multiple lines, and” also appears to be unnecessary;

e) in claim 26, the recitation of “below an intersection” should most likely be --above (or at) an intersection--; and

f) in claim 34, and in accordance with the changes suggested for claim 27, the recitation of “conveying the at least one line” should most likely be --conveying another line--.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5-7, 10-15, 18-22, 25-30, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 6,079,494 to Longbottom et al.

Regarding claims 1, 2, 7, 13, 21, 22, 27, and 28 (as best understood to have at least two lines), Longbottom et al disclose a well completion system and associated method of completing a well that comprises first and second tubular strings, the first tubular string extending in a first wellbore 12a, and the second tubular string extending in a second wellbore 22a intersecting the first wellbore; and lines 64a attached to each of the first and second tubular strings, at least one of the lines extending with the first tubular string in the first wellbore, and at least one of the lines extending with the second tubular string in the second wellbore, wherein the lines are positioned in the first and second wellbores without making a connection or interruption in the lines downhole (see Fig 4A).

Regarding claims 3, 25, and 26, the first tubular string provides access to the first wellbore below an intersection between the first and second wellbores, and wherein the second tubular string provides access to the second wellbore from the first wellbore above the intersection (see Fig. 4A).

Regarding claims 5, 6, 14, 15, 29, and 30, the first line is connected to a first flow control device 58a of the first tubular string, and wherein the second line is connected to a second flow control device 58a of the second tubular string, wherein the first flow control device is positioned in the first wellbore below an intersection between the first and second wellbores, and wherein the second flow control device is positioned in the second wellbore (see Fig. 4A).

Regarding claims 10-12, 18, 19, and 33, one of the lines are attached to a first tubular string extending into a deflector 30a positioned in the first wellbore, wherein at least one of the lines is attached to a second tubular string deflected by the deflector into the second wellbore,

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and further wherein the first tubular string is positioned in the deflector when the second tubular string is deflected by the deflector into the second wellbore (see Figs. 2 and 4A).

Regarding claims 20 and 34, a third tubular string extends in a third wellbore 96 intersecting the first wellbore, and wherein at least one of the lines extends with the third tubular string in the third wellbore (see Fig. 4B).

7. Claims 1, 2, 5-15, 18-22, 25, 27-30, 33, and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by US patent 5,462,120 to Gonduin.

Regarding claims 1, 2, 7, 13, 21, 22, 27, and 28 (as best understood to have at least two lines), Gonduin discloses a well completion system and associated method of completing a well that comprises first and second tubular strings, the first tubular string extending in a first wellbore, and the second tubular string extending in a second wellbore intersecting the first wellbore; and lines 56 attached to each of the first and second tubular strings, at least one of the lines extending with the first tubular string in the first wellbore, and at least one of the lines extending with the second tubular string in the second wellbore, wherein the lines are positioned in the first and second wellbores without making a connection or interruption in the lines downhole (see Figs. 2a, 12, and 13, as well as col. 18, Case 8a).

Regarding claims 5, 6, 14, 15, 29, and 30, the first line is connected to a first flow control device 55 of the first tubular string, and wherein the second line is connected to a second flow control device 55 of the second tubular string, wherein the first flow control device is positioned in the first wellbore below an intersection between the first and second wellbores, and wherein the second flow control device is positioned in the second wellbore (see Figs. 12 and 13).

Regarding claims 8, 9, 20, and 34, an inherent third tubular string extends in an inherent third wellbore intersecting the first wellbore, and wherein at least one of the lines extends, without connections or interruptions, with the third tubular string in the third wellbore (see Figs. 12 and 13, as well as col. 18, Case 8a where it is stated that more than two strings can be hung by the hanger).

Regarding claims 10-12, 18, 19, and 33, one of the lines are attached to a first tubular string extending into a deflector 3 positioned in the first wellbore, wherein at least one of the lines is attached to a second tubular string deflected by the deflector into the second wellbore, and further wherein the first tubular string is positioned in the deflector when the second tubular string is deflected by the deflector into the second wellbore (see Figs. 1-1c).

Regarding claim 25, the first tubular string provides access to the first wellbore below an intersection between the first and second wellbores (see Figs. 12 and 13).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out

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the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claims 4, 16, 17, 31, and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Longbottom et al in view of US patent application publication 2003/0085815 to Tilton et al.

Longbottom et al teach the system and method of completing a well from claims 2, 13, and 28 above. However, it is not explicitly taught that the lines are connected to sensors in the strings.

Tilton et al teach a system and method of completing a well similar to that of Longbottom et al, wherein there is are lines attached to tubular strings, although the line has connections downhole. It is further taught that the lines are connected to sensors (or components, which are taught to include sensors in paragraph [0004]) in each of the tubular strings (see Fig. 30A). It would have been obvious to one of ordinary skill in the art, having the teachings of Longbottom et al and Tilton et al before him at the time the invention was made, to modify the system and method taught by Longbottom et al to include the sensors of Tilton et al, in order to obtain vital wellbore data. One would have been motivated to make such a combination since Tilton et al has shown it to be notoriously known in the art that sensors can be attached to multiple tubular strings, and then connected to the surface via lines along the strings (see again paragraph [0004]).


Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Brown and Koehler et al teach well completion systems of particular interest.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shane Bomar whose telephone number is 571-272-7026. The examiner can normally be reached on Monday - Thursday from 6:30am to 4:00pm. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


David J. Bagnell
Supervisory Patent Examiner
Art Unit 3672


tsb

November 10, 2005